

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES

In re Patent Application of: ) Attorney Docket No.: F-170  
Edward P. DANIELS Jr. et al. ) Group Art Unit: 2167  
Application No.: 09/862,377 ) Examiner: Le, M.  
Filed: May 22, 2001 ) Date: January 23, 2007  
Confirmation No.: 8688

Title: SYSTEM AND METHOD FOR OBTAINING AND TRACKING UP-TO-THE-MINUTE DELIVERY LOCATIONS OF EMPLOYEES VIA A DATABASE SYSTEM

**Mail Stop Appeal Brief - Patents**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**REPLY BRIEF UNDER 37 C.F.R. § 41.41**

Sir:

Pursuant to 37 C.F.R. § 41.41, Appellants present this Reply to the Examiner's Answer mailed December 6, 2006. If any fees are required in connection with the filing of this paper, Appellants request that they be charged to Deposit Account No. 16-1885.

## **REMARKS**

### **I. Status of Claim Rejections**

In response to the Appeal Brief filed October 16, 2006, the Examiner has maintained the rejection of claims 1-10 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,157,945 to Balma et al.

### **II. Response to Examiner's Arguments in Examiner's Answer**

Appellants respectfully traverse the rejection of claims 1-10 under 35 U.S.C. § 102(e) for the reasons discussed in the Appeal Brief. Further, Appellants respectfully disagree with the assertions set forth in the Examiner's Answer and provide the following response.

- A. In the Examiner's Answer at page 11, lines 20-22 it was asserted that
- “appellant has never clearly defined what ‘corporate preference’ means either in the claims or in the specification but just refers to it as ‘the corporate preference and business rules data 12’ (Specification, page 9, line 22).

Appellants respectfully disagree.

Embodiments of the “corporation's preference” recited in independent claims 1, 5, and 7-10 are fully described in the Specification with reference to Figs. 1 and 2 at least at page 8, line 17 to page 9, line 24; page 12, lines 8-15; and page 14, lines 1-4. As described in the Specification, aspects of the corporation's preference include “business rules and preferences (which would apply to all employees).” Specification at page 8, lines 18-19. Further, “[s]ome preferences may be set up as ‘mandatory preferences’ which cannot be overridden by the recipient.” Id. at page 9, lines 3-4. Still further, “[e]mployees may be limited in their access to their preference information based on the corporation preference and business rules data 12.” Id. at page 12, lines

8-9. Additional description of the corporation's preference is provided in the Specification, along with a description of how it relates to the system as a whole.

It was further asserted in the Examiner's Answer at page 11, line 22, to page 12, line 2, that "it would not be proper for the examiner to give words of the claim special meaning when no such special meaning has been defined." Appellants agree and respectfully request that, instead of a "special meaning," the claim terms be given "their broadest reasonable interpretation **consistent with the specification**," as required by M.P.E.P. § 2111. (Emphasis added).

B. In the Examiner's Answer at page 12, line 6, it was asserted that "as seen in Fig. 6, Balma discloses the 'Corporation Preference' providing business rules/preferences." Appellants respectfully disagree.

There is no teaching in the entire Balma disclosure, much less in Fig. 6 of Balma, of the "corporation's preference" recited in independent claims 1, 5, and 7-10. Moreover, the explicit teachings of Balma teach away from such an interpretation.

Balma instead teaches a system that utilizes a recipient's preferences. For example, according to Balma, "it is an object of the invention to provide a system for routing any communication . . . using the mode of communication which is **preferred by the recipient**." Balma at col. 1, lines 39-43. (Emphasis added). Further, the "task which is accomplished by the network illustrated in FIG. 1 is the routing or forwarding of communications to a recipient, using the mode of communication **preferred by the recipient**." *Id.* at col. 4, lines 19-22. (Emphasis added.) Still further, the "network office appliance 100 will be programmed . . . to forward the received facsimile communication

to the recipient at the location of the recipient using the **preferred communication mode of the recipient.**” *Id.* at col. 5, lines 10-16. (Emphasis added).

Balma contains multiple other examples showing the system’s reliance on the recipient’s preferences, not a “corporation’s preference,” as claimed. In fact, the only teaching in Balma of the use of any mode of communication other than a recipient’s preference is an “automatic selection of the mode of communication” used “if the profile of a user is not complete enough.” *Id.* at col. 4, lines 39-42. In that instance, Balma describes the “default conversion” as an “automatic decision” to “properly forward communications in an appropriate format” to complete a transmission. *Id.* at lines 45-55.

In the Examiner’s Answer at page 13, line 3, it was asserted that the above-described automatic decision “can be [equated] to corporate rules which may override all corporate user’s ‘recipient’s delivery preference.’” Appellants respectfully disagree. Balma provides no teaching of overriding a recipient’s preference. To the contrary, the express object of the invention is “to provide a system for routing any communication...using the mode of communication which is **preferred by the recipient.**” Balma at col. 1, lines 39-43. (Emphasis added).

According to M.P.E.P. § 2131, “to anticipate a claim, the reference must teach every element of the claim.” As discussed above and in Appellants’ Brief, Balma fails to teach the “corporation’s preference” recited in independent claims 1, 5, and 7-10. Thus, those claims are allowable over the Balma reference. Claims 2-4 and 6 depend directly or indirectly from claims 1 and 5 and therefore should be allowable for at least the same reasons the claims from which they depend are allowable.

**III. Conclusion**

In view of the foregoing, Appellants respectfully request that the rejection be reversed and withdrawn.

Please grant any extensions of time required to enter this brief and charge any additional required fees to our Deposit Account No. 16-1885.

Respectfully submitted,

/Christopher H. Kirkman/  
Christopher H. Kirkman  
Reg. No. 46,223  
Attorney for the Appellants  
Telephone (203) 924-3852

PITNEY BOWES INC.  
Intellectual Property and  
Technology Law Department  
35 Waterview Drive  
MSC 26-22  
Shelton, CT 06484-8000